Remarks:

Claims 1-9, and 11-20 are pending in the current application. Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) . Claims 1, 11-13, 16 and 20 are amended to distinctively claim the subject matter of the invention. No new matter has been added. Support for the amended language is provided in the specification and the drawings. The Applicant respectfully traverses the 103 grounds of rejection. It is submitted that the application, as amended, is in condition for allowance. Reconsideration and reexamination are respectfully requested.

**§103 Rejection(s):**

Claims 1-9 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,299,322 (hereinafter referred to as "the Yokota reference") in view of U.S. Patent Application Number 2004/0127198 (hereinafter referred to as "the Roskind reference").

The Examiner contends that it would have been obvious to incorporate the teachings of Roskind into the method of Yokota in order to replace or to modify the illumination selected by a user of Yokota with the threshold value(s) from the user or the illumination preferences. Additionally, the Examiner admits that the Yokota reference fails to teach, suggest nor disclose the first and second threshold values from the user or the illumination preferences. This rejection is respectfully traversed.

Yokota discloses a device, for a portable radio, capable of selectively adjusting the illumination of displays or keys. The disclosed device comprises a controller and adjustment circuits between the power source and the illuminating LEDS for turning the LEDS ON and OFF, or adjusting their illumination.

The Yokota reference is directed to "an illuminating device for a portable radio apparatus … capable of selectively turning on or turning off illumination in accordance with the environment around the apparatus, particularly lightness." [See Abstract]. Yokota is further suggests that "the illuminating device includes light sensing means, it causes control means to automatically turn on or turn off illumination and adjusts an illumination in accordance with lightness around the apparatus." [See Abstract]. The object of the Yokota reference seems to be to "provide an illuminating device for a portable radio apparatus capable of reducing power consumption as far as possible." [See col. 1, lines 47-48]. This objective is met by including in a portable radio apparatus "illuminating elements for illuminating the keys and the display. A switching circuit selectively turns on or turns off the illuminating elements. An adjusting circuit adjusts an illumination of the illuminating elements to desired one. An

6

inputting section allows the user of the apparatus to selectively input the turn-on or the turn-off of the illuminating elements and a desired illumination. A controller feeds command signals to the switching circuit and adjusting circuit in accordance with information input on the inputting section." [See col. 1, lines 47-48].

Yokota discloses "a key input section 14 and a memory 15 are also connected to the controller 13. The key input section 14 allows the user to turn on or turn off the LEDs 10 or select a desired illumination on (e.g., the mode key 2b, FIG. 1). Specifically, when the user operates the mode key 2b to, for example, turn on or turn off the LEDs 10, the key input section 14 sends a corresponding signal to the controller 13. The memory 15 stores turn-on or turn-off or an illumination state selected by the user." [See col. 2, lines 57-65]. Thus the user manually selects the illumination intensity.

Yokota further discloses "the light sensing section 35 sends its output representative of the intensity of light incident thereto to the controller 13. The controller 13 processes the sensor output in order to determine the degree of lightness around the handy phone 1. The controller 13 then delivers an LED ON/OFF command signal to the switching circuit 11 in accordance with the degree of lightness determined. In this manner, the controller 13 automatically turns on or turns off the LEDs 10 in matching relation to the environment in which the handy phone 1 is used." [See col. 4, lines 21-30].

Additionally, Yokota discloses "the light sensing section 44 sends a signal representative of the intensity of light incident thereto to the controller 13. In response, the controller 13 processes the input signal to thereby determine the degree of lightness around the handy phone 1, and then reads a combination of ON/OFF state and illumination matching with the degree of lightness out of the memory 15. In this manner, the illustrative embodiment is capable not only of automatically turning on or turning off the LEDs 10 in accordance with the environment around the handy phone 1, but also automatically adjusting even an illumination." [See col. 4, lines 51-61].

Thus, according to Yokota, the automated light intensity is incrementally modified based on the light intensity level, with no input or contribution from the user. Further Yokota's system does not have the ability to automatically adjust only the display or only the keys, and neither the ability to automatically adjust the mobile device display to a different illumination intensity.

Claim 1 is amended to more distinctly recite the elements of the invention. Yokota fails to disclose "measuring a first intensity of ambient light for the mobile device using a light sensing

mechanism; receiving first and second ambient light intensity threshold values from the user of said mobile device; storing said first and second ambient light intensity threshold values in said mobile device; comparing the first intensity with said first and second ambient light intensity threshold values; adjusting illumination intensity of a first illuminating mechanism that illuminates a first user interface component of the mobile device, when the first intensity is not approximately equal to the first ambient light intensity threshold value; and adjusting illumination intensity of a second illuminating mechanism that illuminates a second user interface component of the mobile device, when the first intensity is not approximately equal to the second ambient light intensity threshold value," as recited in claim 1.

Particularly, Yokota fails to teach, suggest or disclose a device that comprises "receiving first and second ambient light intensity threshold values from the user of said mobile device; storing said first and second ambient light intensity threshold values in said mobile device; comparing the first intensity with said first and second ambient light intensity threshold values; adjusting illumination intensity of a first illuminating mechanism that illuminates a first user interface component of the mobile device, when the first intensity is not approximately equal to the first ambient light intensity threshold value; and adjusting illumination intensity of a second illuminating mechanism that illuminates a second user interface component of the mobile device, when the first intensity is not approximately equal to the second ambient light intensity threshold value."

Yokota only discloses a mobile device user's manual adjustment of the individual illuminated display and keys of the mobile device by manually pressing illumination adjustment keys on the mobile device. It is respectfully submitted that the Yokota reference does not disclose separate automated illumination intensity adjustments for the individual display and keys of the mobile device, rather the automated adjustment is collectively applied to the LEDs 10 of the mobile device, not individually to the LEDs 20a and 20b, the display and keys respectively, of the Yokota disclosure.

The Roskind et al. reference discloses a method for automatically changing the notification mode used by a mobile communications device to alert a user of an incoming communication to the mobile communications device. The notification mode is changed in response to a detected environmental condition. The mobile communications device monitors one or more environmental conditions, such as motion, light, sound, and heat, and compares the detected level of each environmental condition to a predetermined threshold. In response to the comparison result, the mobile communications device automatically change the notification mode used to alert a user to an incoming communication.

The Roskind reference discloses "techniques [that] automatically change the notification mode used by a mobile communications device to alert a user of an incoming communication to the mobile communications device. The notification mode is changed in response to a detected environmental condition." [See Abstract]. Roskind further discloses "the notification mode may be changed from one of audible notification, visual notification, and haptic notification to another of audible notification, visual notification, and haptic notification. Adjusting the notification mode may include configuring the mobile communications device to alert a user to an incoming communication by using an audible mode, a visual mode, or a haptic mode," [See par. 0006, lines 6-13], and with respect to the ambient light environment, where "a detected level of light is below a threshold of light, the notification mode may be adjusted to a visual notification. Similarly, a detected level of light is above a threshold of light, the notification mode may be adjusted from a visual notification to an audible notification or a haptic notification," [See Para. 0006, lines 24-29]. Additionally, Roskind discloses "the mobile communications device monitors one or more environmental conditions, such as motion, light, sound, and heat. [See Para. 0018, lines 1-3].

Roskind further discloses two different thresholds that are cited by the Office Action, the first threshold is disclosed as "The mobile communications device compares the level of the monitored environmental condition with a predetermined magnitude threshold for the type of environmental condition monitored (step 320). This may be accomplished, for example, using a table, a list, or other type of data collection that includes a predetermined threshold for each type of environmental condition monitored. The mobile communications device accesses the predetermined threshold for the type of environmental condition and compares the detected environmental condition level to a predetermined threshold. " [See Para. 0049, lines 1-11 and Figure 3].

The second threshold is disclosed as "when the mobile communications device determines that the detected environmental condition has exceeded the predetermined magnitude threshold (step 330), the mobile communications device determines whether the change has persisted or otherwise been experienced for a predetermined threshold period of time (step 340). The predetermined time period threshold indicates the shortest time interval (that is, a time period) during which the environmental condition must persist for a change to be made to the notification mode of the mobile communications device. In other words, the predetermined time period threshold indicates the minimum amount of time during which the environmental condition must persist to warrant a change in the notification mode. The same predetermined time period threshold may be used for all types of environmental conditions, or an individual predetermined time period threshold may be used for each monitored environmental condition. The use of a predetermined time period threshold may help improve the efficiency of the process 300 by

9

reducing the number of brief environmental conditions that cause a change in the notification mode of the mobile communications device." [See Para. 0051, lines 1-22 and Figure 3].

Roskind further discloses a method to reduce changes in the notification mode when environmental conditions exist for brief periods of time, where "the predetermined time period threshold indicates the minimum amount of time during which the environmental condition must persist to warrant a change in the notification mode. The same predetermined time period threshold may be used for all types of environmental conditions, or an individual predetermined time period threshold may be used for each monitored environmental condition. The use of a predetermined time period threshold may help improve the efficiency of the process 300 by reducing the number of brief environmental conditions that cause a change in the notification mode." [See Para. 0051, lines 1-11].

Roskind further discloses "the CPU 232 may modify the notification mode when an environmental condition is within a particular threshold range (e.g., greater than one threshold and less than a second, different threshold). For example, the CPU 232 may detect a sound level that is within a particular threshold range and increase the volume of an audible notification mode based on the sound level. The CPU 232 may turn off the audible notification mode when the sound level exceeds the second threshold (as when the maximum audible notification mode is insufficient to be heard over the sound level in the environment). [See Para. 0045, lines 1-11]. Additionally, Roskind discloses "In some implementations, the action required may be determined based on a combination of environmental conditions, whether the environmental condition is below a predetermined threshold, whether the environmental condition is within a predetermined range of thresholds (e.g., above a particular threshold and below a different threshold) and/or whether the environmental condition is outside a predetermined range of thresholds (e.g., below a particular threshold and above a different threshold). [See Para. 0057, lines 1-9].

Roskind fails to disclose a first and a second "ambient light intensity threshold" values that may be received from a user, as recited in claim 1. Additionally, Roskind still further fails to disclose a correlation between the two unrelated thresholds of a light intensity magnitude (the first threshold) and a specified time period (the second threshold), that are disclosed in Roskind paragraphs [0049] and [0051] as well as in Figures 2 and 3, to the separate elements of the mobile device comprising the keys and the display. Thus it is respectfully submitted that the first and second thresholds of Roskind are not the same as the recited first and second thresholds in claim 1.

10

That is, it is unreasonable to conclude that comparing the intensity of ambient light measured by the ambient light sensor to a second threshold consisting of a period or unit of time that is specified by a user disclosed in Roskind is the same as comparing the intensity of ambient light measured by the ambient light sensor to a user specified ambient light threshold, recited in claim 1. Roskind's unit of time threshold establishes a method to avoid numerous changes in the notification modes when there are a significant number of brief environmental conditions that would change the notification mode. This teaching is contrary to claim 1.

Roskind further fails to disclose "establishing a stable illumination intensity state for the first and second illumination mechanism wherein a user defined predetermined range about each of the first and second thresholds is established by a first and second lower bound and a first and second upper bound, wherein the first illumination mechanism intensity is adjusted when the ambient light intensity is less than the first bound and greater than the first upper bound, and wherein the second illumination mechanism intensity is adjusted when the ambient light intensity is less than the second bound and greater than the second upper bound." Establishing a stable illumination intensity based on a range about the threshold values is not the same as using a period of time as the basis of reducing changes in the notification modes.

Therefore, it is respectfully submitted that the second threshold of a period of time at S340 of Roskind is not the same as the second threshold of ambient light intensity that is compared to the measured ambient light intensity provided by the light sensor to determine the on/off illumination state of the second user interface component of the mobile device, as recited in claim 1. The Examiner admits that the Yokota reference does not teach, suggest nor disclose the first and second threshold values from the user or the illumination preferences. As such, Roskind and Yokota individually, or in combination, fail to teach, suggest or disclose all of the elements of the claimed embodiment.

"In rejecting claims under 35 U.S.C. §103, the examiner bears the initial burden of presenting a prima facie case of obviousness. 'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" In re Rijkaert, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

Regarding Claims 1, 11, and 20 it is respectfully submitted that the Applicant has carefully reviewed the cited portions of the references. The Roskind reference fails to cure the deficiencies of the Yokota reference. Thus, the combination of the two references fails to teach, suggest or disclose every element of claim 1.

The Examiner contends the Roskind reference is in the same field of endeavor and that it would have been obvious to incorporate the teachings of Roskind into the device of Yokota in order to automatically change an illumination of a mobile device based on environmental condition. The Examiner further contends that Yokota and Roskind disclose a mobile communication device with adjusting light intensity, thus they have the same field, purpose and goals. Despite the above general statements, the Examiner has not provided any reason why it would be common knowledge to modify the Yokota reference in the direction of the present invention or combine the two cited references.

"The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner." MPEP §2144.03.

MPEP §2143 provides:

> "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998) (emphasis added).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of the references' disclosures.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. <u>In re Geiger</u>, 2 USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner, rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, Applicants invite the Examiner to point out the alleged motivation to combine with specificity,[1] or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.[2]

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn, or the Examiner is requested to point out the portions of the cited references that teach or suggest such elements, or their combination, with specificity.

For the above reasons, it is respectfully submitted that the Yokota reference alone or in combination with the Roskind reference, fails to teach, suggest or disclose the recited elements in amended claim 1. Amended claims 11 and 20 substantially incorporate the elements of claim 1, therefore claims 11 and 20 should also be in condition for allowance. Claims 2 through 9 depend on claim 1, and claims 12 through 19 depend on claim 11, and should be in condition for allowance by the virtue of their dependence on an allowable base claim.

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless

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1 *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).
2 "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

It is submitted that this application is now in good order for allowance and such allowance is respectfully solicited.  Should the Examiner believe that there are matters relating to this application remaining that can be resolved in a telephone interview, the Examiner is urged to call the Applicant's undersigned attorney.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (888) 789 2266 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

/F.JasonFar-hadian,Esq./

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